

**Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 1792**

N81438AJA

Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jiann-Hsing Chen, et al

METHOD FOR PRODUCING A
REPLACEABLE FUSER MEMBER

Serial No. 10/662,913

Filed 15 September 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Group Art Unit: 1792

Examiner: Elena Tsoy

Confirmation No. 1253

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested based on the following arguments.

ARGUMENTS

Claim Rejections – 35 U.S.C. § 103

In the Final Rejection mailed April 10, 2008, the Examiner has maintained the various rejections of claims 1-3, 5-6, 8-11, 14 and 16-18 under 35 USC § 103(a) for the reasons set forth in paragraphs 6-11 of the Office Action mailed 10/15/2007. All of such stated rejections are based on “Applicants’ admitted prior art”, with the Examiner referencing page 5, lines 1-15 and claim 19 as originally filed, and stating that such “Jepson” claim format constitutes an implied admission that the subject matter of the preamble is the prior work of another (citing *In re Fout*), in view of various cited references. While it is initially

pointed out that Applicants' specification does not credit another as the inventor of the subject matter of the preamble as was apparently the case in *In re Fout*, Applicants have in any event submitted a Declaration under 37 CFR 132 by two coinventors of the present application establishing that the referenced alleged "admitted prior art" refers to Declarants' own work, and thus is not the work of another. Accordingly, any "implied" admission of prior art has been overcome, and such alleged "admitted prior art" cannot be used to form the basis of any proper obviousness rejection. As the Examiner has continued to rely on such alleged "admitted prior art" in all stated grounds of rejection under 35 USC § 103(a), all such rejections represent clear error and should be removed.

The Examiner states that the fact that the preamble of the Jepson format claim of original claim 19 is Declarants' own work is insufficient to overcome the rejection of the claims based on the cited prior art because the limitations of the preamble were well known in the art, as evidenced by the Hartley et al and Chen et al references, as explained in the paragraph 7 of the Office action mailed 10/10/2006. Such statement represents further clear error, as it is inconsistent with the stated grounds of rejection actually set forth in the Final Rejection, as such "admitted" prior art is still relied upon in all stated grounds of rejection. Further all stated grounds of rejection do not rely on Hartley et al and Chen et al., and such statement by the Examiner is thus not clear as to the status of all the rejections. Additionally, such Hartley et al and Chen et al references in any event do not disclose all limitations of the preamble of original claim 19 (e.g., there is no disclosure in such references of a method of producing a replaceable fuser member adapted to be positioned on a machine mandrel in a fuser system, wherein a sleeve is mounted on a mandrel configured to receive the sleeve over the outside of the mandrel).

The Examiner erroneously equates the "cylindrical core" of the fuser described in these references to the nickel sleeve employed in the present invention. There is no basis for such position, as the cylindrical core of the prior art is itself the rigid core element of the described fuser rollers of the prior art (see, e.g., col. 7, lines 60-66 of Hartley et al.), to which the further described layers are directly coated, rather than a replaceable sleeve mounted on a mandrel, wherein the mandrel is configured to receive the sleeve over the outside of the mandrel as employed in the present invention. While the claimed use of a coated

sleeve in combination with a mandrel itself clearly differentiates from a rigid core itself, it is further noted that claim 5 additionally sets forth thickness limitations for the sleeve that further distinguish the claimed invention from the prior art use of rigid cylindrical cores upon which the remaining layers of the fuser roller are directly coated.

Finally, in the Advisory Action mailed July 9, 2008, the Examiner states that “the Examiner relied on Applicants’ Admission (ASA) that the current invention is directed to improvements in the fabrication process of replaceable fuser members for fuser rollers in electrophotographic applications whereby good adhesion is provided between the layers of cured material including the member and whereby increased ease of installation and reduced replacement (See specification, page 4, lines 8-15)”, and that “the only Applicants’ admission that Examiner relied upon is that the fabrication process of replaceable fuser members for fuser rollers in electrophotographic applications (i.e., a method of producing a replaceable fuser member adapted to be positioned on a machine mandrel in a fuser system, wherein a sleeve is mounted on a mandrel configured to receive the sleeve over the outside of the mandrel) was known in the art...”. A statement as to what the invention is directed to, however, is not necessarily itself an “admission” as to what constitutes available prior art. To the contrary, as explained above, Applicants’ Declaration under 37 CFR 132 establishes that the base line subject matter refers to Applicants’ own work, and is accordingly not an admission of prior art available for rejection of the claimed invention.

Accordingly, it is respectfully submitted that to the extent all stated grounds of rejection under 35 USC 103 continue to rely on alleged “admitted prior art”, such rejections are in clear error and should be removed. To the extent the Examiner’s comments in the Final Rejection and Advisory Action are interpreted to mean the Examiner is now relying upon some proposed new basis for rejection (which has not been articulated in the actually stated grounds of rejection) where Hartley et al and Chen et al references are now alleged as teaching all features of the previously alleged “admitted prior art”, such reliance is clearly in error as explained above. Removal of such rejections upon review thereof accordingly respectfully urged.

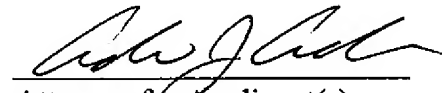
Claim Rejections – 35 U.S.C. § 112

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. In the Final Rejection, the Examiner states that curing the topcoat “at a temperature of 275°C or more” is not described in the specification, as the specification includes the statement of curing up to a temperature of *about* 275°C or more, and thus the specification limits the curing to about 275 °C. Such rejection represents clear error, as the cited passage from the specification at page 10, lines 23-24 itself states “or more”, and the specification elsewhere further teaches possibility of curing at a temperatures higher than 275 °C (see, e.g., page 5, lines 18-19, which describes curing at temperatures up to at least 300 °C without distortion). Thus, the specification clearly does not absolutely limit the temperature only up to 275°C , but rather clearly teaches higher temperatures may be employed. As explained in Applicants’ response filed November 20, 2007, while Applicants have not committed resources to find the absolute upper temperature limit for the claimed curing step (i.e., the temperature wherein the topcoat composition no longer cures and decomposes), one skilled in the art could do so without undue experimentation. Accordingly, the claim is adequately enabled.

It is in any event further noted that Applicants’ have previously requested entry of an amendment after final that would delete such temperature recitation and thus reinstate the original claim language with respect to curing of the topcoat (which original claim language was not rejected under 35 USC 112), in order to moot such issue and advance this application to issuance. While the Examiner has denied entry of such amendment after final as not be entitled “as a matter of right” (even though no new issues as to indefiniteness are raised, but rather raised issues are instead clearly eliminated), it is requested that such amendment after final be entered to place the application in condition for allowance upon withdrawal of the clearly erroneous final rejections based on the “admitted prior art”.

In view of the above, it follows that the Examiner has clearly not established a *prima facie* case of obvious of the subject matter of the claims relative to applicable prior art. Rather, the rejections of the claims are clearly in error, and withdrawal of such rejections is courteously solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.